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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,258	02/25/2002	Kiran Venkatesh Hegde	DAND0004	3975
75671 7590 02/08/2011 Sadler, Breen, Morasch & Colby, ps 601 W. Main Ave. Suite 1300 Spokane, WA 99201				
EXAMINER				
STORK, KYLE R				
ART UNIT		PAPER NUMBER		
2178				
NOTIFICATION DATE		DELIVERY MODE		
02/08/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptocorrespondence@sbmc-law.com

### Office Action Summary

**Application No.**

10/084,258

**Applicant(s)**

HEGDE ET AL.

**Examiner**

KYLE R. STORK

**Art Unit**

2178

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3.5-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3.5-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12.3.10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This non-final office action is in response to the remarks filed 10 December 2010.
2. Claims 1-3, 5-21, and 23-28 are pending. Claims 1, 10, and 16 are independent claims.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5, 9-11, 16-17, and 23-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 7,155,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite substantially similar limitations. Please note that the citation correspond to the column and line number of the published patent.

With respect to claim 1, the copending application discloses:

receiving an indication over a network, in response to a request for access to a rich media presentation by an internet browser on a network device, that the internet browser on the network device has requested access to the rich media presentation (column 16, lines 30-34)

in response to the receiving an indication, detecting one or more attributes of one or both of rich media capabilities associated with the internet browser or rich media capabilities associated with the network device (column 16, line 45)

selecting a rich media presentation to be sent to the internet browser from among a plurality of rich media presentations based on the one or more attributes that are detected, wherein a selected rich media presentation includes a media package selected based on the one or more attributes that are detected and a virtual player configured to play the media package on the network device (column 16, lines 46-60)

With respect to claim 2, the copending application discloses wherein the detecting one or more attributes comprises detecting two or more attributes from: an operating system type attribute, a plug-in attribute, a browser type attribute, a firewall attribute, a monitor setting attribute, a language attribute, a bandwidth attribute, or a protocol attribute (column 17, lines 4-9: Here, an additional, or second attribute is detected in addition to an initial detected attribute).

With respect to claim 3, the copending application discloses wherein the causing the selected rich media presentation to be sent comprises determining whether one or both of the internet browser or the network device supports playing the selected rich media presentation, configuring the selected rich media presentation based on the detected attributes responsive to a determination that playing the selected rich media presentation is supported, otherwise, causing a supported rich media presentation to be sent to the internet browser (column 16, line 61- column 17, line 3).

With respect to claim 5, the copending application discloses allowing a client to modify one or more characteristics associated with the selected rich media presentation (column 16, lines 46-60).

With respect to claim 9, the copending application discloses:

selecting the virtual player configured to play the media package on the network device (column 16, lines 46-60)

selecting a presentation package configured for the network device (column 16, lines 46-60)

selecting the media package (column 16, lines 46-60)

As per claim 10, the applicant discloses the limitations substantially similar to those in claim 1. Claim 10 is similarly rejected.

As per claim 11, the applicant discloses the limitations substantially similar to those in claim 3. Claim 11 is similarly rejected.

As per claim 16, the applicant discloses the limitations substantially similar to those in claim 1. Claim 16 is similarly rejected.

As per claim 17, the applicant discloses the limitations substantially similar to those in claim 3. Claim 17 is similarly rejected.

With respect to claim 23, the copending application disclose causing the selected rich media presentation to be sent to the internet browser (column 16, lines 46-60).

As per claim 24, the applicant discloses the limitations substantially similar to those in claim 2. Claim 24 is similarly rejected.

As per claim 25, the applicant discloses the limitations substantially similar to those in claim 24. Claim 25 is similarly rejected.

As per claim 26, the applicant discloses the limitations substantially similar to those in claim 23. Claim 26 is similarly rejected.

As per claim 27, the applicant discloses the limitations substantially similar to those in claim 24. Claim 27 is similarly rejected.

With respect to claim 28, the copending application discloses detecting the one or more attributes comprises detecting an attribute that indicates a media player type for a media player included on the network device (column 16, lines 46-60).

5. Claims 6-7, 12-14, and 18-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 7,155,436 in view of Armstrong et al. (US 6985934, filed 23 October 2000, hereafter Armstrong).

As per dependent claim 6, the copending application fails to specifically disclose wherein causing the selected rich media presentation to be sent to the network device comprises utilizing an ad serving engine. However, Armstrong discloses wherein causing the selected rich media presentation to be sent to the network device comprises utilizing an ad serving engine (column 2, lines 4-42). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Armstrong with the copending application, since it would have allowed for an ad server to provide advertising content to a user device in a format which the device is capable of displaying.

As per dependent claim 7, the copending application fails to specifically disclose wherein causing the selected rich media presentation to be sent to the network device

comprises utilizing an email serving engine. However, Armstrong discloses wherein causing the selected rich media presentation to be sent to the network device comprises utilizing an email serving engine (column 9, lines 23-32). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Armstrong with the copending application, since it would have allowed an email server to provide content within an email to a user device in a format which the device is capable of displaying.

As per dependent claim 12, the copending application fails to specifically disclose discloses wherein the rich media presentation is configured to be presented with a banner ad that is selectable to cause an action to be performed. Armstrong discloses wherein the rich media presentation is configured to be presented with a banner ad that is selectable to cause an action to be performed (column 1, line 56- column 2, line 42). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Armstrong with the copending application, since it would have allowed a banner ad to be presented to a user in a format with the user's device is capable of displaying.

As per claim 13, the applicant discloses the limitations substantially similar to those in claim 6. Claim 13 is similarly rejected.

As per claim 14, the applicant discloses the limitations substantially similar to those in claim 7. Claim 14 is similarly rejected.

As per claim 18, the applicant discloses the limitations substantially similar to those in claim 12. Claim 18 is similarly rejected.



As per claim 19, the applicant discloses the limitations substantially similar to those in claim 6. Claim 19 is similarly rejected.

As per claim 20, the applicant discloses the limitations substantially similar to those in claim 7. Claim 20 is similarly rejected.

6. Claims 8, 15, and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 7,155,436 in view of Crow et al. (US 6262724, application 1999, hereafter Crow).

As per dependent claim 8, the copending application fails to specifically disclose delivering an image to the device that is displayed on the device at a location relating to the rich media presentation. Crow further discloses the method comprising delivering an image to the device that is displayed on the device at a location relating to the rich media presentation (Figure 4, items 248 and 250: Here, the media source icons are images displayed on the device and the location is related to the corresponding presentation). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Crow with the copending application, since it would have allowed a user to view an image representing the presentation prior to displaying the entire presentation.

As per claims 15 and 21, the applicant discloses the limitations similar to those in claim 8. Claims 15 and 21 are similarly rejected.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle R Stork/  
Primary Examiner, Art Unit 2178